O.I.P.E IAP38
AUG 0 4 2008
PATENT & TRADEMARK OFFICE

Docket No.: 1293.1950

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Kyoung-hwan PARK et al.

Serial No. 10/678,750	Group Art Unit: 2627
Confirmation No. 6605	
Filed: October 3, 2003	Examiner: LaTanya BIBBINS

For: APPARATUS AND METHOD FOR GENERATING TRACKING ERROR SIGNAL AND OPTICAL RECORDING/REPRODUCING SYSTEM USING SAME

PRE-APPEAL BRIEF CONFERENCE REQUEST

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

The Applicants respectfully request review of the rejection mailed May 2, 2008 in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Claims 1-23 are pending. Claims 1-23 are rejected under 35 U.S.C. § 112, 1st paragraph as failing to comply with the written description requirement. Claims 1-23 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,787,076 to Deguchi et al. A pre-appeal brief panel review of the identified appealable issues I, II and III is requested.

I. Rejection under 35 U.S.C. § 112

Independent claims 1 and 11 recite that "the high-pass filter is connected in series between the side beam push pull signal generating unit and the subtractor, and is grounded," independent claims 4, 7, 10, 14, 17 and 20 recite that "the high-pass filter is connected in series between a generator of the SPP signal and a calculator of the difference between the MPP signal and the SPP signal, and is grounded," and independent claim 23 recites that "the high-pass AC component remover is connected in series between a generator of the SPP signal and a calculator of a difference between a main push pull signal and the SPP signal, and is grounded."

The Examiner alleges that the specification does not disclose such an implementation of the high-pass filter. The present specification at paragraph 0042 recites that "[a] filter 703 is connected to an output terminal of the SPP signal generating unit 702 and removes an AC signal component from the SPP signal. As a result, only DC components of the SPP signal are input to a subtractor 704. That is, the filter 703 is designed to have high-pass filtering characteristics or band-pass filtering characteristics. However, when the filter 703 is positioned in series between the SPP signal generating unit 702 and the subtractor 704, the filter 703 is designed to have low-pass filtering characteristics [emphasis added]."

The specification particularly recites that when the filter 703 is connected to the SPP signal generating unit 702, the filter 703 acts with high-pass filtering characteristics, and when the filter 703 is positioned in series between the SPP signal generating unit 702 and the subtractor 704, the filter 703 acts with low-pass filtering characteristics. Thus, the filter 703 may operate as a high pass filter 703 when connected to the SPP signal generating unit 702 and also have low-pass filtering characteristics when positioned between the SPP signal generating unit 702 and the subtractor 704. Further, Fig. 7 clearly shows that the filter 703 is grounded. Accordingly, it is respectfully requested that the § 112 rejection be withdrawn.

II. Official Notice

In the Office Action mailed June 12, 2007, the Examiner conceded that "Deguchi does not specifically disclose a high-pass filter which removes AC components from the SPP signal, Deguchi does however disclose a low-pass filter which removes AC components from the SPP signal." The Examiner then took Official Notice that providing a low-pass filter in series with a signal output results in the equivalent frequency response as connecting a high-pass filter to ground at the signal output since the applicant has not disclosed that a high-pass filter solves any stated problem or is for any particular purpose and it appear that the invention would perform equally well with a low-pass filter in series.

First, the Examiner took Official Notice of "a high-pass filter which removes AC components from the SPP signal." In the Amendment filed August 28, 2007, the Applicants implicitly traversed the Examiner's assertion of Official Notice as to "a high-pass filter which removes AC components from the SPP signal" by arguing that a high-pass filter which removes all AC components from the SPP signal such that only DC components of the SPP signal remain does provide a benefit distinct from that of a low-pass filter in series with a signal output. Namely, providing a high-pass filter which removes an AC component such that only DC components remain results in stably generating a DPP signal regardless of disc track pitch. Thus, as the Examiner stated that the Examiner was taking Official Notice since the Applicant did not disclose that the high-pass filter solves any stated problem and is for any particular purpose, and then the Applicants argued that utilizing a high-pass filter which removes all AC components from the SPP signal such that only DC components of the SPP signal remain does solve a problem and is for a particular purpose, the Applicants did traverse the Examiner's assertion of Official Notice.

In the subsequent Office Action, the Examiner did not include an explanation as to why the traversal was inadequate, as is required by M.P.E.P. § 2144.03. Thus, the Applicants arguments traversed the Examiner's assertion of Official Notice.

Further, while M.P.E.P. § 2144.03 provides guidance to the Examiner as to determining whether the traversal is not adequate and that the Examiner may clearly indicate in the next Office Action that the common knowledge or well-known in the art statement is taken to be admitted prior art, M.P.E.P. § 2144.03 provides no reference to the C.F.R. or to case law that supports that a lack of or inadequate traversal necessarily results in the admission that the statement at issue is admitted prior art. The Applicants respectfully submit that the M.P.E.P. does not recite that the Applicant must acquiesce to this assertion and particularly points out that, when requested, the Examiner must provide substantiary evidence to support his/her contention. Numerous case law invariably support the notion that the Examiner be required to cite a prior art reference, particularly where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. *See In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970). While "Official Notice" may be relied upon, as noted in MPEP § 2144.03, these circumstances should be rare and Official Notice unsupported by documentary evidence should only be taken by the Examiner where the facts asserted to be well known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known and only when such facts are of notorious character and serve only to "fill in the gaps" which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection.

An "assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support." In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Here, the Examiner has failed to provide substantial evidential support for "a high-pass filter which removes AC components from the SPP signal such that only DC components of the SPP signal remain" and the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.

Further, in the Amendment filed February 5, 2008, the Applicants respectfully demanded that a reference be produced and/or an affidavit supporting the same be prepared by the Examiner. The Examiner failed to do so.

In addition, in the Office Action dated May 2, 2008, the Examiner only took Official Notice regarding the same feature – "a high pass filter which removes an AC component from the SPP signal such that only DC components of the SPP signal remain." In the Amendment filed

February 5, 2008, the Applicants amended the claims to recite that "the high-pass filter is connected in series between the side beam push pull signal generating unit and the subtractor, and is grounded." The Examiner did not take explicit Official Notice of this feature, but by reiterating the same Official Notice argument, implicitly took Official Notice of this feature.

In the unentered Amendment and response filed July 1, 2008, the Applicants again implicitly traversed the Examiner's implicit Official Notice regarding that "the high-pass filter is connected in series between the side beam push pull signal generating unit and the subtractor, and is grounded," arguing why it is beneficial to utilize a high-pass filter that has low-pass filter characteristics instead of just a low-pass filter, the high-pass filter having low-pass characteristics by being connected between an SPP signal generating unit and a subtractor and being grounded.

The Examiner has failed to provide a reference that discloses a high-pass filter connected in series between the SPP signal generating unit and the subtractor, and is grounded. Therefore, it is respectfully submitted that the Examiner provide support both for the feature of "a high-pass filter which removes an AC component from the SPP signal such that only DC components of the SPP signal remain" and "the high-pass filter is connected in series between the side beam push pull signal generating unit and the subtractor, and is grounded."

III. Rejection under 35 U.S.C. § 103

The Examiner concedes that Deguchi does not disclose a high-pass filter which removes an AC component from the SPP signal such that only DC components of the SPP signal remain, where the high-pass filter is connected to the terminal of the SPP signal generating unit to ground, but that Deguchi does disclose a low-pass filter which removes AC components from the SPP signal. The Examiner then alleges that "it would have been an obvious matter of design choice to provide a high-pass filter to ground versus having a low-pass filter in series with the SPP signal since the applicant has not disclosed that a high-pass filter solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a low-pass filter in series." KSR International v. Teleflex requires that the Examiner provide "an apparent reason" to modify the art in the manner suggested. The Examiner fails to provide an apparent reason or motivation to connect a high-pass filter in series between an SPP signal generating unit and a subtractor, and ground the high-pass filter.

Reciting only that "the applicant has not disclosed that a high-pass filter solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with a low-pass filter in series" is not an apparent reason that would have led one of ordinary skill in the art to modify Deguchi to provide a high-pass filter connected in series between an SPP signal generating unit and a subtractor, and which is grounded, where the high-pass filter removes an AC component from the SPP signal such that only DC components of the SPP signal remain. Deguchi discusses only the use of a low-pass filter, which does not have high-pass filtering characteristics. The Examiner has failed to cite a motivation as to why the low-pass filter would be replaced with a high-pass filter or why the low-pass filter would be connected between a SPP signal generating unit and a subtractor and be grounded.

Further, the Examiner asserts that it would have been an obvious matter of design choice to provide a high-pass filter to ground versus having a low-pass filter in series with the SPP signal. However, the Examiner failed to provide a motivation or reason for the worker in the art to make the necessary changes in the reference device. *See Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Here, the Examiner failed to provide a motivation as to why the low-pass filter of Deguchi would altered in the manner suggested – so that a high-pass filter that is able to remove an AC component from the SPP signal such that only DC components of the SPP signal remain would be connected in series between the SPP signal generating unit and the subtractor, and also be grounded. Therefore, the Applicants respectfully request withdrawal of the § 103(a) rejection.

Claims 2, 3, 5, 6, 8, 9, 12, 13, 15, 16, 18, 19, 21 and 22 depend either directly or indirectly from independent claims 1, 4, 7, 10, 11, 14, 17, 20 and 23, and include all the features of their independent claims, and therefore patentably distinguish over the reference relied upon.

Conclusion

In accordance with the foregoing, claims 1-23 are pending and under consideration. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited. Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters. If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,
STAAS & HALSEY LLP

Date: 8/4/08

By: Kari P.
Kari P. Footland
Registration No. 55,187

1201 New York Avenue, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501